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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/814,253	04/01/2004	Julio A. Abusleme	108910-00129	6955

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EXAMINER

ZEMEL, IRINA SOPJIA

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 05/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/814,253

Applicant(s)

ABUSLEME ET AL.

Examiner

Irina S. Zemel

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-8, and 11-24 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 5-11 and 16-17 of copending Application No. 10/814339. Although the conflicting claims are not identical, they are not patentably distinct from each other because the scope of the compositions claimed in one application overlaps with the scope of the compositions claimed in the other invention. Both claimed polymers contain majority of CTFE monomer units with minor amounts of the second component. While the second components are defined differently, the presence of minor amounts of additional comonomers that would correspond to the second co-monomer of the other application are not precluded from being present in the claimed copolymers of each application.

Art Unit: 1711

Further, the claimed melting temperatures of the polymers claimed in '339 application is an inherent characteristic of substantial number of the copolymers falling within the scope of the copolymers claimed in the instant application (as evident from related patents, such as 6,107, 393). Thus, the scope of the claimed inventions overlaps for the instant and the referenced application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102/103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-8, 14-16, 18-22 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over US Patent publication 20010003124 to Zolotnitsky et al., (hereinafter "Zolotnitsky").

Zolotnitsky discloses compositions comprising chlorotrifluoroethylene (CTFE) copolymer and various additives. The CTFE polymer disclosed by Zolotnitsky is a copolymer that comprises up to 90 % of CTFE as per expressed disclosure of reference in, for example, [0024] and a copolymerizable monomer disclosed in [0025 and 0029] which fully corresponds to the claimed acrylic comonomers. The reference further expressly disclosed optional components such as polytetrafluoroethylene (PTFE) in the amounts up to 15 %. See [0045-46]. No additional foaming agents is disclosed by Zolotnitsky as necessarily present in the compositions. The reference further

Art Unit: 1711

exemplifies addition of POLYMIST brand PTFE to the disclosed compositions. It is believed that the POLYMIST PTFE which is commercially available from Ausimont which is used in the examples of Zolotnitsky is a powdered and irradiated PTFE with the particle size and other characteristics fully corresponding to the claimed characteristics. (Similar product, in fact, is used as a nucleating agent in the examples of the instant application).

Although the reference does not disclose foams obtained from the The claimed properties of the composition, such as "foamable", the claimed properties are reasonably believed to be an inherent properties of the compositions disclosed by Zolotnitsky since they contain substantially the same components in substantially the same amounts. It is noted that the compositions of Zolotnitsky contain additional components, i.e., flame retardants. However, it is believed that the disclosed flame retardants added in relatively small amounts do not have a negative effect on the compositions foaming properties. The burden is shifted to the applicants to provide factual evidence that the compositions disclosed in Zolotnitsky, in fact, are not foamable.

The invention as claimed thus, is fully within the purview of Zolotnitsky reference.

Claim Rejections - 35 USC § 103

Claims 11-13, 17, 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zolotnitsky.

The disclosure of Zolotnitsky is discussed above. The reference does not expressly addresses the foamed coatings, the reference expressly discloses the preferred use of the disclosed compositions for wire insulation or cable jacketing, which

Art Unit: 1711

are normally, conventionally and routinely obtained by the extrusion coating while operating extruder at temperatures significantly higher melting points of the base polymers. Once the disclosed compositions are processed for their intended use of cable jacketing (wire coating), the cat routine temperatures, it is resonsbly believed that the processed compositions will inherently results in the claimed foamed coatings with the claimed properties as obtained from compositions substantially similar to the claimed compositions (via a routine wire coating process). The burden is shifted to the applicants to provide factual evidence to the contrary.

As far as the limitations of claims 17, the reference does not disclosed amounts of CTFE higher than 90 mole %, but discloses that the properties of the resulting copolymers vary with varying the amounts of respective co-monomers. Thus, the amounts of respective comonomers are considered ti be result effective variable ultimately governing the properties of the final product, and, as such, optimization of the result effective variable would have been obvious for an ordinary artisan to obtain the desired end result.

Response to Arguments

Applicant's arguments with respect to all pending claims and regarding indefiniteness issues have been considered and found acceptable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Irina S. Zemel whose telephone number is (571)272-0577. The examiner can normally be reached on Monday-Friday 9-5.

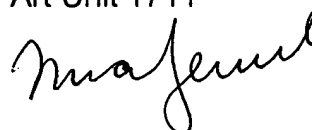
Art Unit: 1711

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571)272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ISZ

Irina S. Zemel
Primary Examiner
Art Unit 1711

A handwritten signature in cursive script, appearing to read 'Irina S. Zemel', written in black ink.